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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,570

12/22/2003

Matthew S. Kissner

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EXAMINER

ALMATRAHI, FARIS S

ART UNIT

PAPER NUMBER

3627

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/707,570	<b>Applicant(s)</b> KISSNER ET AL.	
	<b>Examiner</b> FARIS ALMATRAHI	<b>Art Unit</b> 3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/27/2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of the Application*

1. **Claims 1-20** are pending in this application.
2. **Claims 17-20** are withdrawn from consideration due to non-elected restriction requirement.

### *Election/Restrictions*

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16, drawn to a method for presenting a digital paper bill, classified in class 705, subclass 34.
  - II. Claims 17-20, drawn to a method for electronic payment of a bill, classified in class 705, subclass 40.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as bill preparation. Subcombination II has separate utility such as bill payment. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with George MacDonald on February 5, 2008, a provisional election was made without traverse to prosecute Invention I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 14-16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claim 14** recites the limitation "receiving data relating to a bill from each of a plurality of merchants, each bill including bill data and bill summary data". The limitation as phrased is viewed to be vague and indefinite because it is unclear if data is received from a plurality of merchants on one bill or if each merchant has a separate bill with its own data. Also, there is lack of antecedent basis for the phrase "each bill" as recited in the claim. It is unclear as to the applicant is referring to.

7. **Claim 15** recites the limitations "the payment request includes an indication that the consumer used the digital pen to check an Aoto pattern box indicating a request to pay all bills". The phrase "all" encompasses an open-ended limitation that would overlap subject matter outside the scope of the invention and is therefore viewed as indefinite.

8. **Claim 16** recites the limitation "the payment request includes an indication that the consumer used the digital pen to check an Anoto pattern box indicating a request to pay one bills". It is unclear what the applicant is referring to in the phrase "one bills". The term "one" implies a singular bill but applicant discloses "bills" in the limitation.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-5 and 8-16** are rejected under 35 U.S.C. 102(b) as being anticipated by Wiebe (WO 02/39378 A1).

11. Regarding claims 1 and 14, Wiebe discloses a method for presenting a digital paper consolidated bill comprising: receiving data relating to a bill from each of a plurality of merchants, each bill including bill data and bill summary data (Page 23 lines 26-35); associating a digital paper pattern with a consolidated bill, wherein the consolidated bill includes bill summary data for each bill (Figure 4, page 23 lines 26-35); providing a digital paper bill representation of the consolidated bill to a consumer (Page 23 line 36 – Page 24 line 4).

12. Regarding claim 2, Wiebe discloses a method further comprising: receiving a payment request from the consumer, wherein the consumer uses a digital pen to process the payment request (Page 23 lines 26-35); authenticating the payment request (Page 13 line 36 – Page 14 line 4); and processing a bank payment request from a bank in order to process the payment request (Page 24 lines 5-31).
13. Regarding claim 3, Wiebe discloses a method further comprising: obtaining a consumer payment preferences record used for processing the bank payment request (Page 24 lines 26-31).
14. Regarding claim 4, Wiebe discloses a method further comprising: requesting a funds availability determination from the bank relating to the payment request (Page 24 line 32 – Page 25 line 2).
15. Regarding claim 5, Wiebe discloses a method further comprising: receiving a payment processed notice from the bank relating to the payment request (Page 24 lines 12-31, receiving back a network address of the bank's computer reads on a payment processed notice).
16. Regarding claim 8, Wiebe discloses a method wherein, the consumer uses a cellular telephone to process the payment request (Page 21 lines 28-33).
17. Regarding claim 9, Wiebe discloses a method wherein, the payment request includes an indication that the consumer used the digital pen to check an Anoto pattern box (Abstract, Page 6 line 22 – Page 7 line 2).
18. Regarding claim 10, Wiebe discloses a method wherein, the digital paper comprises a unique Anoto pattern (Page 23 line 36 - Page 24 line 4).

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19. Regarding claim 11, Wiebe discloses a method wherein, the digital paper comprises a generic Anoto pattern and a payment check box including a unique Anoto pattern (Page 23 line 36 - Page 24 line 19).
20. Regarding claim 12, Wiebe discloses a method wherein, the payment request includes an indication that the consumer used the digital pen to write a payment amount in an Anoto pattern box (Page 20 lines 5-15, Page 24 lines 12-19).
21. Regarding claim 13, Wiebe discloses a method wherein, the payment request includes an indication that the consumer used the digital pen to check a payment dispute Anoto pattern box (Page 24 lines 5-11, invoice in question reads on payment dispute).
22. Regarding claims 15-16, as best understood, Wiebe discloses a method wherein the payment request includes an indication that the consumer used the digital pen to check an Anoto pattern box indicating a request to pay bills (Page 24 lines 12-19).

***Claim Rejections - 35 USC § 103***

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. **Claims 6-7** are rejected under 35 U.S.C 103(a) as being unpatentable over Wiebe (WO 02/39378 A1) in view of official notice.



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25. Regarding Claim 6, Wiebe fails to explicitly disclose a method further comprising sending a payment processed receipt to the consumer related to the payment processed notice.

26. However, Examiner takes official notice that sending a payment processed receipt to the consumer related to the payment processed notice is old and well known in the art at the time the invention was made.

27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a method comprising sending a payment processed receipt to the consumer related to the payment processed notice, for the advantage of providing a consumer with payment verification.

28. Regarding Claim 7, Wiebe fails to explicitly disclose a method wherein, the data relating to a bill includes XML formatted data.

29. However, Examiner takes official notice that XML formatted data is old and well known in the art at the time the invention was made.

30. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a method wherein, the data relating to a bill includes XML formatted data, for the advantage of providing consumers with a common and standardized data format.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571) 270-3326. The examiner can normally be reached on Monday to Friday 9:00 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627

Faris Almatrahi  
Examiner  
Art Unit 3627

FA